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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
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In re Application of Hubert Koster et al. :
Serial No.: 09/335,705 :
Filed: November 5, 1999 : PETITION DECISION
Attorney Docket No.: 24743-2303US :
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This is in response to applicants' petition, filed August 20, 2002 under 37 CFR 1.144, requesting withdrawal of the restriction requirement set forth by the examiner.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 on November 5, 1999 as the national stage of international application PCT/US98/02007, filed February 4, 1998, which claimed priority to U.S. provisional application 60/037,165, filed February 4, 1997. The application, as filed with a preliminary amendment, contained claims 1-51 and 53-56. In an Office action mailed October 2, 2001, the examiner set forth a restriction / lack of unity requirement under 35 U.S.C. 121 and 372 dividing the claims into 6 groups, as follows:

Group I, claims 1-28, 44-47 and 53-56, drawn to a composition and method for making same.

Group II, claims 29-35, 37 and 38, drawn to an oligonucleotide and a nucleoside.

Group III, claims 39-43, drawn to proteins and peptides.

Group IV, claims 48 and 49, drawn to a method of nucleic acid purification.

Group V, claim 50, drawn to a method of sequencing a target nucleic acid.

Group VI, claim 51, drawn to a method of genetic expression profiling.

Applicants replied by electing, with traverse, Group I, claims 1-28, 44-47 and 53-56. Applicants argued that the inventions of groups IV-VI are methods of using the composition of group I, and therefore should be examined together with group I. On June 17, 2002, the examiner mailed a non-final Office action. The examiner maintained the restriction requirement, stating that all of the groups lack unity of invention.

Representative claims read as follows:

1. A composition, comprising two biopolymers, wherein:
the first biopolymer is linked to an insoluble support by a reversible linkage; and
the second biopolymer is linked to the first biopolymer by a reversible linkage.
44. The composition of claim 1, wherein:
the first biopolymer is a nucleic acid;
the insoluble support is linked via a spacer to the nucleic acid through a reversible heterobifunctional trityl group;
the second biopolymer is an enzyme; and
the nucleic acid is conjugated to the enzyme through a reversible chelate complex.
48. A method of purification, comprising:
contacting the composition of claim 44 with products of nucleic acid amplification procedures,
whereby the products are purified.

DISCUSSION

In the petition, as in their previous response, applicants argue that any one of groups IV-VI should be rejoined with group I. This argument is unpersuasive. When there is more than one method of use claimed, the first method mentioned in the claims is considered to be the main invention (37 CFR 1.475(d)). Therefore if any group were to be rejoined with group I, it would be group IV.

37 CFR 1.475(a) states, in part:

Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

MPEP 1850 states, in part:

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression "category of claim" referring to the classification of claims according to the subject matter of the invention claimed, for example, product, process, use or apparatus or means, etc.).

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. Equally, no problem arises in the case of a genus/species situation where the genus claim avoids the prior art. Moreover, no problem arises in the case of a combination/subcombination situation where the subcombination claim avoids the prior art and the combination claim includes all the features of the subcombination.

If, however, an independent claim does not avoid the prior art, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered. If there is no

link remaining, an objection of lack of unity (that is, arising only after assessment of the prior art) may be raised. Similar considerations apply in the case of a genus/species or combination/subcombination situation.

Since independent claims are compared first, claim 48 is compared to claim 1, not to claim 44. It is noted that claim 1 has been rejected by the examiner as anticipated by either of two different prior art references. Therefore it is concluded that claim 1 does not include a special technical feature within the meaning of PCT rule 13.2. No inventive link is seen between the composition of claim 1 and the method of claim 48, and applicants have not pointed out any inventive link between the two claims.

DECISION

Applicants's petition is **DENIED** for the reasons set forth above.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-4205 or by facsimile transmission at (703) 746-5006.

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